

REMARKS

By this Amendment After Final, Applicants have added new claim 61. No new matter has been added. Claims 1-26 and 41-61 are pending on the merits.

As an initial matter, Applicants appreciate the Examiner's indication that claims 41, 42, and 59 are allowed. For at least the reasons explained in more detail below, Applicants respectfully submit that all of other pending claims, claims 1-26, 43-58, 60, and 61 are allowable.

I. Section 103(a) Claim Rejection Based on Grabowski et al. in Combination with Granek et al. and Wootton

In the Office Action, claims 1-8 and 60 were rejected under 35 U.S.C. § 103(a) based on Grabowski et al. (U.S. Patent No. 3,713,491) in combination with Granek et al. (U.S. Patent No. 4,058,167) and Wootton (U.S. Patent No. 3,848,231). Claims 1 and 60 are the only independent claims rejected under § 103(a) based those references, and Applicants respectfully traverse that rejection because the final Office Action has failed to establish a *prima facie* case of obviousness at least because there is no suggestion or motivation to make the rejection statement's proposed, hypothetical modification to the Grabowski et al. reference's disclosure.

Under the guidance of the M.P.E.P., in order "[t]o establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." § 2143. Furthermore, "[t]he teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in applicant's disclosure." Id. The M.P.E.P. further advises that "[t]he mere

fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Id. In fact, the M.P.E.P. advises that “[i]t is improper to combine references where the references teach away from their combination.” § 2145(X)(D)(2) (citation omitted).

In the Office Action, the rejection statement apparently concedes that neither the Grabowski et al. reference nor the Wootton reference discloses or suggests “that a system of fire detectors and suppressant dischargers can be configured such that detection of the fire condition in any one of the storage units does not necessarily result in discharging of fire suppressant material into others of a plurality of storage units” Final Office Action at 3. Nevertheless, the rejection statement asserts that the above recited subject matter is disclosed in the Granek et al. reference and concludes that “[i]t would have been obvious . . . to activate only the suppressant dischargers in a system such as taught by Grabowski et al. located in a storage unit that experiences a fire condition when the interconnected devices are placed in separate storage units constituting individual monitoring zones such as taught by Granek when the system is applied to a storage area environment having multiple storage units, since cargo cars, ships and aircraft sometimes comprise multiple storage units, in order to prevent unnecessary use of fire suppressant.” Id.

Applicants respectfully traverse the rejection statement’s proposed, hypothetical modification to the Grabowski et al. reference at least because the rejection statement’s proposed modification is contrary to the Grabowski et al. reference’s explicitly-disclosed objects and advantages. For example, the Grabowski et al. reference discloses that “[a]nother feature of th[e] invention is the provision of a fire protection system formed by

a plurality of portable fire suppressors . . . and [a] control circuit network . . . adapted to produce sympathetic actuation and resultant extinguishing medium discharge from all units in response to fire detection by any of the associated fire detectors.” (Col. 2, lines 30-39 (emphasis added)). The Grabowski et al. reference also discloses that “[b]y strategically locating the individual suppressor units, a completely automatic fire extinguishing system can be established for a protection zone of any size and configuration.” (Col. 2, lines 39-43.)

In other words, the only disclosure in the Grabowski et al. reference relating to the use of multiple portable fire suppressors, concerns using the multiple portable fire suppressors to produce sympathetic actuation and resultant extinguishing medium “discharge from all units” (emphasis added) in response to fire detection by any of the associated fire detectors, and to establish a “protection zone of any size and configuration.” By modifying the Grabowski et al. reference’s fire protection system “to activate only the suppressant dischargers in a system such as taught by Grabowski et al. located in a storage unit that experiences a fire condition,” as asserted in the rejection statement, it would necessarily defeat one of the explicitly-disclosed objects of the Grabowski et al. reference. As a result, the Grabowski et al. reference teaches away from the rejection statement’s proposed, hypothetical modification.

Therefore, there is no legally proper suggestion or motivation to make the rejection statement’s proposed, hypothetical modification to the Grabowski et al. reference’s disclosure. Consequently, the final Office Action has failed to establish that Applicants’ independent claims 1 and 60 are *prima facie* obvious. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of those claims.

II. Section 103(a) Claim Rejection based on Grabowski et al. and Wootton

In the final Office Action, claims 18-25, 43-49, and 52-57 were rejected under 35 U.S.C. § 103(a) based on Grabowski et al. in combination with Wootton. The only independent claims rejected based on that combination of references are claims 18, 43, and 52. Applicants respectfully traverse that rejection because there is no suggestion or motivation to make the rejection statement's proposed, hypothetical modification to the Grabowski et al. reference's disclosure.

In the final Office Action, the rejection statement refers to the previous Office Action, which apparently concedes that neither Grabowski et al. nor Wootton discloses or suggests that "the claimed first signal is infrared." Office Action dated January 30, 2004, at 5. Nevertheless, the rejection statement asserts that "it would have been obvious . . . that other wireless links, including an infrared link, can be used in a system such as taught by Grabowski et al. and Wootton without unexpected results, whereby infrared can specifically be chosen if radio interference may be a problem in the application environment." Id. at 5. Furthermore, in the "Response to Remarks" section, the final Office Action asserts that "Applicant's hypothetical line of sight limitations associated with infrared signals, again, depends on the environment as indicated in the previous Office Action rejection of claim 8 so that infrared signals may advantageous[ly] [sic] be used if there is line of sight and there is radio interference, for example." Final Office Action at 7.

As outlined above, in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify a reference. M.P.E.P. § 2142. Furthermore, such a suggestion or motivation must be found either in the references

themselves or in the knowledge generally available to a person having ordinary skill in the art rather than in an applicant's own disclosure. Id.

Applicant respectfully submits that since the final Office Action has not identified a reference that supports its assertion that "infrared signals may advantageous[ly] [sic] be used if there is line of sight and there is radio interference," the final Office Action must be relying on either Applicants' own disclosure or on an apparent assertion that such knowledge is generally available to a person having ordinary skill in the art. If the Examiner insists on maintaining the claim rejection under 35 U.S.C. §103(a) based on the apparent, unsupported assertion that skilled artisans would have been motivated to modify the Grabowski et al. reference's disclosure relating to hard-wired portable fire suppressors to send wireless signals via infrared transmission in the manner suggested by the final Office Action, Applicants respectfully request that the Examiner supply a personal affidavit supporting those assertions, so that Applicants will be provided with an opportunity to respond appropriately. See M.P.E.P. § 2144.03 (citing 37 C.F.R. § 1.104(d)(2), which requires an Examiner to supply a personal affidavit including specific facts supporting an Examiner's assertion of personal knowledge). Applicants respectfully request such an affidavit since it appears that the Examiner is either relying on the Examiner's personal knowledge or on improper hindsight and the teaching of Applicants' own disclosure to supply the suggestion or motivation for making the selective and hypothetical modifications to the Grabowski et al. disclosure to arrive at Applicants' systems, as recited in independent claims 18, 43, and 52. In the absence of such an affidavit or some other legally valid supporting evidence, the final Office Action has failed to establish that any of independent claims 18, 43, and 52 is *prima facie* obvious based on the Grabowski et al. and Wootton references.

Furthermore, in the final Office Action's "Response to Remarks" section, it is asserted that "Grabowski et al. does not prevent the remote alarm indication signal to be separated from [Grabowski et al.'s disclosed] sympathetic actuation signals," and that "nothing in Grabowski et al. prevents the sympathetic actuation signals to be implemented wirelessly" Final Office Action at 7 (emphasis added).

Applicants respectfully note that the final Office Action's above-noted assertions about how Grabowski et al. "does not prevent" modification indicates an apparent improper basis for analyzing whether a modification to a reference's disclosure is proper under 35 U.S.C. § 103(a). The proper basis for analyzing whether a modification to a reference's disclosure is proper under § 103(a) is not whether the reference being modified prevents the proposed modification, but rather whether there is some legally supportable suggestion or motivation to make the proposed modification. See e.g., M.P.E.P. § 2143. In the absence of such a suggestion or motivation, a claim rejection under § 103 is improper for failing to establish a *prima facie* case of obviousness.

For at least the above-outlined reasons, each of Applicants' independent claims 18, 43, and 52 is patentably distinguishable from the Grabowski et al. and Wootton references, taken individually or in combination. Therefore, each of Applicant's independent claims 18, 43, and 52 is allowable.

Rejections of Dependent Claims under Section 103(a)

In the Office Action, claims 2-17, 19-26, 44-51, and 53-58 were rejected under 35 U.S.C. § 103(a) based on Grabowski et al. in combination with Wootton either alone or in further combination with at least one of Granek et al., Eguchi (U.S. Patent No. 3,909,814), Fierbaugh (U.S. Patent No. 4,987,958), and Sears (U.S. Patent

No. 6,032,745). None of those references discloses or suggests the above-outlined subject matter that is neither disclosed nor suggested by the Grabowski et al. and Wootton references. Furthermore, since each of those claims depends from one of independent claims 1, 18, 43, and 52, they should be allowable for at least the same reasons their corresponding independent claims should be allowable.

Conclusions

For at least the reasons set forth above, independent claims 1, 18, 41, 43, 52, and 60 should be allowable. Dependent claims 2-17, 19-26, 42, 44-51, 53-59, and 61 depend from one of independent claims 1, 18, 41, 43, 52, and 60. Consequently, those dependent claims should be allowable for at least the same reasons their respective independent claims are allowable.

Therefore, Applicants respectfully request reconsideration of this application, withdrawal of the outstanding claim rejections, and allowance of claims 1-27 and 41-61.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicants' undersigned attorney at 571-203-2739.

Applicants respectfully submit that the final Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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